

REMARKS

Applicants present claims 1-10, 17, 25-27 and 29-39 for examination.

The Examiner rejected claims 1-10, 17, 25-27 and 29-39 under 35 U.S.C. §112, second paragraph as allegedly being indefinite. In particular, the Examiner stated “The statement ‘the shape memory alloy material is not polyvinyl alcohol’ is not a positive statement and does not in any way ha[ve] patentable meaning.” *See* Office Action mailed August 24, 2009, p. 2. Applicants disagree with the Examiner’s position. As explained in the M.P.E.P.:

... there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. *See* M.P.E.P. § 2173.05(i).

Here, the boundaries of the patent protection provided by claims 1-10, 17, 25-27 and 29-39 are set forth definitely. In other words, in light of the specification, one skilled in the art would readily understand that subject matter covered by these claims. Applicants therefore request reconsideration and withdrawal of the rejection of claims 1-10, 17, 25-27 and 29-39 under 35 U.S.C. §112, second paragraph.

The Examiner maintained his rejection of claims 1-10, 17, 25-27 and 29-39 under 35 U.S.C. §102(e) as allegedly being anticipated by Bourne et al., U.S. Patent No. 7,131,997 (“Bourne”) “substantially for the reasons of record.” *See* Office Action mailed August 24, 2009, p. 3. However, as Applicants previously explained, Bourne simply does not disclose, for example, one or more generally spherical particles that include a shape memory material that is not polyvinyl alcohol. Nor has the Examiner pointed to a disclosure of shape memory material in Bourne. Instead, in the prior Office Action (on which Applicants assume the Examiner relies when maintaining the rejection “substantially for the reasons of record”)¹, the Examiner

¹ Applicants find the Examiner’s use of the word “substantially” confusing and therefore request clarification on this point. Is the Examiner raising any new grounds of rejection based on information allegedly disclosed in Bourne? If the answer to this question is yes, Applicants believe the Examiner must state such grounds explicitly. If the answer

generically referred to more than 40 lines of text in Bourne as allegedly disclosing a shape memory material. *See* Office Action mailed March 23, 2009, p. 3. However, this section of Bourne merely discloses certain porous particles that can have a "symmetric compressibility profile". *See* Bourne at col. 6, lines 44-45. As would be understood by one skilled in the art, this is not tantamount to an explicit disclosure of a shape memory material that is not polyvinyl alcohol. To the extent the Examiner holds a contrary view, the Examiner is reminded that, as explained at MPEP §2144.03 (emphasis in original):

[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. *See also In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979) ("[W]hen the PTO seeks to rely upon a chemical theory, in establishing a prima facie case of obviousness, it must provide evidentiary support for the existence and meaning of that theory."); *In re Eynde*, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) ("[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.").

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings."). While the court explained that, "as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction," it made clear that such "expertise may provide sufficient support for conclusions [only] as to peripheral issues." *Id.* at 1385-86, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697.

to the question is no, then Applicants do not understand why the Examiner uses the term "substantially" and ask that the Examiner explain why he is using the term "substantially".

In other words, should the Examiner wish to maintain his position that Bourne discloses a shape memory material that is not polyvinyl alcohol, the Examiner must provide evidence to support this position. Nor has the Examiner established that Bourne inherently discloses a shape memory material that is not polyvinyl alcohol. As stated by the United States Court of Appeals for the Federal Circuit in *Electro Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994), “[t]he mere fact that a thing may result from a given set of circumstances is insufficient to prove anticipation.” (citations omitted; emphasis original). Instead, one asserting that a reference inherently discloses certain subject matter must prove that the features are “necessarily present [in the prior art reference] and that it would be so recognized by persons of ordinary skill.” (*Id.*) Here, the Examiner has not satisfied the requisite legal standard. Furthermore, in the portion of Bourne relied upon by the Examiner, Bourne discloses polyvinyl alcohol particles. In contrast the claims cover a shape memory material that is not polyvinyl alcohol. In view of the foregoing, Applicants request reconsideration and withdrawal of the rejection of claims 1-10, 17, 25-27 and 29-39 under 35 U.S.C. §102(e).

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Respectfully submitted,

Date: September 22, 2009

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